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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

112740-177

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Application Number

09/806,594

Filed

March 30, 2001

First Named Inventor

Wolfgang Fraas et al.

Art Unit

2616

Examiner

R. Chang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

48,196

Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Peter Zura

Typed or printed name

312-807-4208

Telephone number

June 22, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Wolfgang Fraas et al.
Appl. No.: 09/806,594
Conf. No.: 4492
Filed: March 30, 2001
Title: METHOD FOR CONNECTING EXCHANGES VIA A PACKET-ORIENTED
COMMUNICATION NETWORK
Art Unit: 2616
Examiner: R. Chang
Docket No.: 112740-177

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated February 22, 2007, and Advisory Action dated June 8, 2007. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 7-12 remain in the present application. Independent claim 7 is the focus of this request. As detailed below, Applicants argue that the current rejections are improper and should be reversed by this Board. Applicant notes that this is the second such request for the present application.

Claims 7 and 9-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Bernstein et al.* (US Patent 6,404,765) in view of *Bernet* (US Patent No. 5,764,645) and further in view of *Westberg* (US Patent No. 6,041,054).

Claims 11 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Bernstein et al.* (US Patent 6,404,765) in view of *Bernet* (US Patent No. 5,764,645) and *Westberg* (US Patent No. 6,041,054) and further in view of *Suzuki* (US Patent No. 6,330,239).

Applicants maintain the request for clarification is the present rejection. As was argued previously, the Office Action recites claim features that are not found in the language of the claims. For example, on page 4, second paragraph, the Office Action recites the feature of "Internet protocol data packet over ATM network." On page 5, second paragraph (and also paragraph 4), the Office Action recites that "the substructure elements may be inserted into the data packets in an arbitrary order." These features are not found in any of the claims. Clarification is kindly requested.

None of the cited references, alone or in combination, teach or suggest subdividing the Internet Protocol data packets into substructure elements, or "inserting, via the transmitting conversion device, the substructure elements into the subdivided Internet Protocol data packets unchanged, wherein no compression or decompression of the voice data is performed; transmitting the Internet Protocol data packets from the transmitting conversion device to a receiving conversion device; [and] extracting, via a receiving conversion device associated with a receiving one of the connecting exchanges, the substructure elements from the received Internet Protocol data packets, wherein no compression or decompression of the voice data is performed" as recited in claim 7. As argued previously, the recited method generally discloses steps for transparently transmitting data in the form of substructure elements through a packet-oriented communication network using IP data packets (e.g., transmission of ATM cells over an IP network.).

Bernstein discloses the transmission of DS-X traffic over an ATM packet-network (col. 3, line 66 - col. 4, line 6). A conversion circuit (210) performs a DS-X-to-ATM conversion, where packet engine 230 specifies virtual channels where data is transmitted (col. 5, line 47 - col. 6, line 2). Thus, Bernstein does not disclose “inserting, via the transmitting conversion device, the substructure elements into the subdivided Internet Protocol data packets unchanged” - Bernstein does not “insert” any substructure elements, but clearly converts the DS-X traffic to ATM. Moreover, Bernstein clearly teaches that compression is performed to save bandwidth: “according to the present invention, virtual connection or slot provisioning and/or cell concentration techniques are used to compact the amount of DS-X traffic broadcast between communications system devices such as the end node and the communications switch to spare bandwidth” (col. 4, lines 1-6).

Bernet fails to solve the deficiencies of Bernstein discussed above. Besides providing an isolated disclosure regarding an ATM/IP protocol stack (col. 3, lines 25-33), the Office Action provides no information how such a configuration would conceivably be incorporated into the teaching of Bernstein. The Advisory action noted that Bernstein contemplated a DS-X to IP conversion, as well as an ATM conversion (Bernstein, col. 11, lines 3-35). However, Bernet teaches the efficient use of ATM network resources in conjunction with a higher level IP network protocol (col. 3, lines 25-33). Thus, if the teaching of Bernet were to be combined with Bernstein, Bernstein would have to convert to ATM in order to avail itself of the teachings of Bernet, since Bernet relies on an IP network dependent upon an underlying ATM network protocol (see col. 4, lines 28-29, 38, 56-61). As was argued previously by Applicants, ATM is a cell-relay circuit switched network, which is incapable of transmitting “Internet protocol data packets from the transmitting conversion device to a receiving conversion device.” If Bernstein converts all DS-X traffic into ATM, it is not understood how Internet Protocol packets would be utilized in such a configuration. Moreover, such a configuration is the opposite of the claimed features (“inserting, via the transmitting conversion device, the substructure elements into the subdivided Internet Protocol data packets” (note: not ATM packets))

Regarding Westberg, the document teaches that IP data packets get transmitted through an ATM network (col. 3, lines 5-7), which is the opposite of the claimed configuration. Westberg also does not teach or suggest an inserting of the substructure elements (cell header and payload) into IP data packets unchanged, and further relies on compression/decompression

in transmitting packet data (col. 7, lines 1-12). In Fig. 2 of Westberg, the reference discloses different size AAL2 minicells in the top row compared to the bottom row, whereas differently sized cells in the top row appear as same sized blocks in an ATM cell (e.g. third AAL2 minicells from the right and second AAL2 minicells from the right are clearly different in size in the top row but roughly the same size in the bottom row). Accordingly, the AAL2 minicells will not stay unchanged when they get inserted into an ATM cell.

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary consideration (e.g., the problem solved). *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ2d 459, 467 (1966). “[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) (“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed. *KSR*, 127 S. Ct. at 1732, 82 USPQ2d at 1389.

Appellant respectfully submits that the Office Action has improperly piecemealed individual features from multiple references to arrive at the present rejection. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 127 S. Ct. at 1732. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir.

1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying on *ex post* reasoning." *KSR* 127 S. Ct. at 1740.

In addition to the arguments provided above, the references clearly teach away from each other. The Office Action states that Bernstein does not disclose transmitting "Internet Protocol data packet over ATM [sic] network" (page 4, lines 5-6). However, this is the opposite of what is being claimed (as evidenced by the subdividing/inserting steps which demonstrate ATM being transmitted over IP packets). Moreover, if Bernstein and Bernet disclose compression for the effective transmission of data, for what apparent reason would one skilled in the art not compress the data? This expressly runs counter to the teachings in both references. For at least these reasons, the Applicants respectfully submit the rejection under 35 U.S.C. §103 is improper and should be reversed.

In light of the above, Applicants respectfully submit that independent claim 7 of the present application, as well as claims 8-12 which respectfully depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicants respectfully If any fees are due in connection with this application as a whole, the office is hereby authorized to deduct said fees from Deposit Account No.: 02-1818.

Respectfully submitted,
BELL, BOYD & LLOYD LLC

BY



Peter Zura
Reg. No. 48,196
Customer No.: 29177
Phone: (312) 807-4208

Dated: June 22, 2007